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PATENT
Customer No. 22,852
Attorney Docket No. 04329.2622



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Gaku MINAMIHABA, et al.) Group Art Unit: 2823
Serial No.: 09/932,943) Examiner: Lee, Hsien Ming
Filed: August 21, 2001)
For: SLURRY FOR CHEMICAL)
MECHANICAL POLISHING AND)
METHOD OF MANUFACTURING)
SEMICONDUCTOR DEVICE)

Mail Stop Issue Fee

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Request for Supplemental Notice of Allowability and
Comments on Statement of Reasons for Allowance

Applicants submit this paper to request a Supplemental Notice of Allowability, for the reasons that follow. Applicants submit that the Examiner inaccurately characterized Applicants' claims in the Examiner's statement of reasons for allowance.

Applicants point out an inaccurate characterization of the claims the Examiner's statement of reasons for allowance in the "Allowable Subject Matter" section of the September 16, 2003 Notice of Allowability. Applicants note that the statement of reasons for allowance is part of the prosecution history, and the failure of Applicants to comment on reasons for allowance may give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom. *See M.P.E.P. §1302.14, 8th Ed. (Rev. Feb. 2003), pp. 1300-13.*

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Specifically at issue is the Examiner's statement that "the slurry includes *third* particles formed of a material *different* from those of the first and second colloidal silica particles ... and that the slurry contains a *surfactant*, which is *dodecyl benzene sulfonate*." (Notice of Allowability, p. 2, italics in original). Allowed independent claims 18 and 23 disclose, in part, "a slurry for chemical mechanical polishing, which contains polishing particles comprising first colloidal silica particles whose primary particles have a diameter ranging from 5 to 20 nm, and second colloidal silica particles whose primary particles have a diameter ranging from 20 nm to 50 nm." Applicants have already demonstrated that the cited references do not teach or suggest at least this element of Applicants' independent claims 18 and 23.

Accordingly, Applicants point out that the Examiner improperly grouped elements of Applicants' dependent claims 22, 28, 29, and 34 – 36 with elements of independent claims 18 and 23 in the statement of reasons for allowance.

Since the Examiner's statement does not refer only to the allowed independent claims, it could *erroneously* give the impression that Applicants' present invention was allowed only because of the elements of dependent claims 22, 28, 29, and 34 – 36, which is not the case. This would have the effect of improperly narrowing the scope of Applicants' claimed invention. Applicants therefore dispute the Examiner's mischaracterization of the claim scope and accordingly request a Supplemental Notice of Allowability containing a revised statement of reasons for allowance of Applicants' independent claims 18 and 23.

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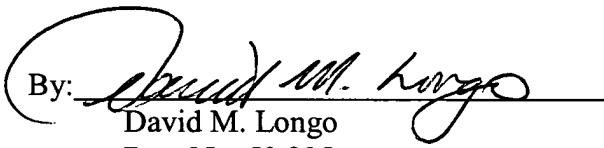
If there is any fee due in connection with the filing of these Comments, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 24, 2003

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